

AMENDMENTS TO THE SPECIFICATION:

Replace paragraph [0159] with new paragraph where “effective” has been changed to “enforceable”

[0159] A deposit of the Agrigenetics, Inc. d/b/a Mycogen Seeds proprietary inbred corn line MN7224 disclosed above and recited in the appended claims has been made with the American Type Culture Collection (ATCC) 10801 University Boulevard, Manassas, Virginia 20110. The date of deposit was September 3, 2003. The deposit of 2,500 seeds were taken from the same deposit maintained by Agrigenetics, Inc. d/b/a Mycogen Seeds since prior to the filing date of this application. All restrictions upon the deposit have been removed, and the deposit is intended to meet all of the requirements of 37 C.F.R. §1.801-1.809. The ATCC accession number is PTA-5451. The deposit will be maintained in the depository for a period of 30 years, or 5 years after the last request, or for the ~~effective~~ enforceable life of the parent, whichever is longer, and will be replaced as necessary during that period.

REMARKS

The specification and claims have been amended to more precisely define the invention. In particular, new claims 34-44 have been added to the application and the specification has been amended in keeping with a suggestion made by the Examiner. In view of the nature of the amendments, it is submitted that no new matter has been added to the application.

Claims 9-10 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In support of the rejection, the Examiner alleged that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is traversed and it is submitted that claims 9-10 are in full compliance with the requirements of 35 U.S.C. § 112, first paragraph.

Initially, the Examiner is urged to appreciate that claims 9-10 are directed to hybrid plants and seeds produced with corn plant MN7224 as one parent. As set forth in the present specification, corn plant MN7224 is an inbred corn plant. All of the

claimed hybrid plants having MN7224 as a parent will therefore contain a copy of the same genome as corn plant MN7224. That is, because MN7224 is an inbred corn plant, hybrid corn plants derived therefrom will have as half of their genetic material the same genetic contribution of corn plant MN7224, notwithstanding the possibility of a rare spontaneous mutation or undetected segregating locus. Furthermore, this entire contribution of corn plant MN7224 is described in the specification by way of the deposit of seed of corn plant MN7224 with the ATCC. This represents a description of concrete and identifiable structural characteristics defining the claimed hybrid plants and distinguishing them from other plants in full compliance with the written description requirement. Accordingly, reconsideration and withdrawal of the rejection of claims 9-10 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement are requested.

Claims 1-33 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In support of the rejection, the Examiner alleged that the claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is traversed and it is submitted that the claims in the application are in full compliance with the requirements of 35 U.S.C. § 112, first paragraph.

In support of this rejection, the Examiner alleged that Applicants have not provided any indication that a viability test was conducted. The Examiner is urged to appreciate that the ATCC provided Applicants with a viability statement confirming that seed of MN7224 deposited under ATCC Accession No. PTA-5451 were viable. In further support of the rejection, the Examiner alleged that paragraph [0159] should be amended to replace the term "effective" with the term "enforceable." In keeping with the Examiner's suggestion, "effective" has been changed to "enforceable" in the referenced paragraph. Accordingly, reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement are requested.

Claims 9-10 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,284,955 to Marshall. This rejection is traversed and it is submitted that the claims are in full

compliance with the requirements of 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a).

It is well-settled that the Examiner is charged with the initial burden of establishing a **prima facie** basis to deny patentability to a claimed invention under any statutory provision. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Anticipation requires the disclosure in a single reference of each element of a claimed invention. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 102, the Examiner is required to identify wherein an applied reference discloses each feature of the claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinefabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

As set forth above, claims 9-10 are directed to hybrid plants and seeds produced with corn plant MN7224 as one parent. It is apparent, however, that “MN7224” is conspicuously absent from the disclosure of Marshall. The Examiner failed to identify wherein Marshall discloses inbred corn line MN7224. It is, therefore, apparent that the Examiner committed clear error in determining that Marshall discloses each element of the claimed invention. **Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc., supra.**

In rejecting a claim under 35 U.S.C. §103, the Examiner must provide a factual basis to support the conclusion that one having ordinary skill in the art would have been motivated to modify the applied prior art to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 873 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

In Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1597 n. 42, 1 USPQ2d 1593, 1606 n. 42 (Fed. Cir. 1987), the Court underscored the necessity to resolve patentability issues with a view to the real world. Accordingly, it is necessary to interpret Marshall realistically through the eyes of one having ordinary skill in the art. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Marshall discloses a corn hybrid designated P724 which may be used to pollinate an elite male sterile hybrid grain parent to impart high oil concentration to the resulting F1 grain. It is submitted that one having ordinary skill in the art, out in the real world with Marshall in hand, would have been led away from selecting

hybrids produced with corn plant MN7224 as one parent because the Examiner has simply failed to present any evidence, or scientific evidence for that matter, that a hybrid produced with corn plant MN7224 could be used to pollinate an elite male sterile hybrid grain parent to impart high oil concentration to the resulting F1 grain. Thus, it can hardly be said that Marshall would have placed the claimed invention in the hands of the public.

The Examiner's reliance upon *In re Thorpe, supra.* is misplaced. In *Thorpe*, under the particular facts of that case, it was determined by the Board that the applied prior art references disclosed the same product as that claimed but was prepared by a different process. Importantly, Thorpe did not contest the determination that the product of his process was different from the prior art product. In affirming the Board's determination, the Court of Appeals for the Federal Circuit noted that:

[t]he examiner compared the product of the prior art, and the product of Thorpe's process described by Thorpe, in accord with the standard examination practice, noting the similarity of reactants, reaction conditions, and properties. (*In re Thorpe*, 227 USPQ at 97, emphasis added).

The Examiner's reliance upon a decision where the Examiner compared the prior art product with the product covered by the product-by-process claim and established a *prima facie* case is erroneous. In the present case, the Examiner has failed to make any comparison whatsoever between the actual hybrids plants disclosed in Marshall and the actual hybrid plants disclosed in the present application. Instead, The Examiner relied upon the mere possibility that claimed hybrids might somehow be identical to or obvious from Marshall's hybrids. Had the Examiner made such a comparison, it would have been evident that the hybrids of Marshall are different and unobvious from the hybrids of the present invention. The Examiner's attempt to impress the *Thorpe* rationale on the present case is, therefore, misplaced and clearly erroneous.

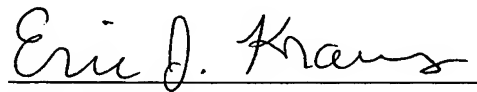
Applicants respectfully submit that the manifest weaknesses in the applied prior art scotch the Examiner's erroneous legal conclusion that one having ordinary skill in the art would have found the claimed subject matter as a whole obvious within the meaning of 35 U.S.C. § 103. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). Accordingly, reconsideration and withdrawal of the rejections under 35

U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) are requested.

In view of the amendments and remarks presented with this response, it is urged that the rejections of record are overcome and the present application is in condition for allowance.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 04-1529 and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in cursive script, reading "Eric J. Kraus", written over a horizontal line.

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